

REMARKS

Claims 1, 4-7, 9-13, and 16-26 remain pending in the present application. Claim 1 has been amended to correct the numeration of the various elements that are claimed therein. Claim 4 has been amended to correct its dependency in view of a previous claim cancellation. Support for this amendment is found in Claim 3 as originally filed. No new matter, however, has been added.

Invention Synopsis

The present invention relates to a disposable article comprising: A) a liquid impervious backsheet; B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core positioned between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Applicants have found that such articles resulting from the claimed method yield articles that exhibit an improved efficacy in aiding in the adherence of bowel movement to the skin of the wearer, thereby improving the ease of cleaning up the typical mess associated with such events.

Formal Matters

The Office stated in the Office Action that the clean copy of Claim 1 in the previously filed amendment was not correct. Accordingly, Applicants have amended Claim 1 once again to ensure that Claim 1 is correct. Pursuant to the new rules governing claim amendments, the amendments are denoted via underlined and stricken through type in Claim 1 that was submitted via facsimile on September 11, 2002. Thus, this issue has been addressed.

Rejection Under §103

Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan (USP 3489148). The Office reasons that Duncan discloses the following: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying

the diameter of the lotion droplets. As a result of these assertions, the Office concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Duncan with the claimed percent open area. Applicants respectfully traverse this rejection.

Duncan relates to a diaper having an oleophobic-hydrophobic topsheet, the outer face of which is coated with a film of discrete droplets of an oleaginous moisture barrier material suitable for application to an infant's skin. Furthermore, the reference discloses that when "discontinuous surface films of a protective barrier material were therefore applied to the topsheet of disposable diapers to eliminate the need for separately applying the protective barrier by the parent at the time of diaper change"..."it was found that this approach was not effective on diapers which did not have a hydrophobic backsheet." See, col. 1, line 71 – col. 2, line 9. Moreover, Duncan teaches that such hydrophobic topsheets functioned quite well with a freshly applied barrier film on its hydrophobic topsheet but tended to have a deleterious effect on the diaper when aged past the normal range of shelf life. This deleterious effect was taught to be a reduction in the in-use capacity of the diaper. See, col. 2, lines 9 – 16. Applicants, however, find no teaching in the reference of the absorbent article of the present invention that includes a liquid impervious backsheet; a liquid pervious, **hydrophilic topsheet** joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core position between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.

Applicants respectfully submit that the present invention would not have been obvious at the time Applicants arrived at the invention in view of the disclosure of Duncan. First, although the Office asserts that hydrophilic topsheets were known in the art since Duncan opts to utilize a oleophobic-hydrophobic topsheet, Applicants maintain that the claimed combination offers benefits that were not appreciated by Duncan or those skilled in the art prior to the disclosure of Duncan. First, as has been asserted previously by Applicants, Duncan fails to teach or suggest the liquid pervious, hydrophilic topsheet that is required by Applicants' claimed invention. In contrast, the reference teaches away from the inclusion of such a component via Duncan's disclosure of the utility of a hydrophobic topsheet as is known in the art when discontinuous surface films of a protective barrier material are applied to a topsheet. Additionally, Duncan teaches away from Applicants' hydrophilic topsheet in its invention which includes an oleophobic-hydrophobic topsheet. In particular, it is an object of the Duncan invention to provide a diaper topsheet having a critical surface tension that is sufficiently low in contrast with the surface tension of the

oleaginous moisture barrier material and with that of waste fluids to prevent a drop of either from spreading on the web. See, col. 3, lines 64 – 68 of Duncan. A disadvantage of the Duncan topsheet, however, is that such a topsheet is slow in promoting transfer of urine to the underlying absorbent cores. See, page 3, lines 13-15 of the present application. The Duncan reference goes on to teach various coatings or treating materials which can be employed to lower the surface tension of the web of the topsheet. See, col. 4, lines 34-49. Each of these teachings goes squarely against the heart of the present invention which is directed toward providing a topsheet that is hydrophilic in its very nature by way of its constituents (whether by hydrophilic fibers or films or by hydrophilic coatings for such fibers or films), particularly in the macroscopic untreated regions where lotion is not present.

Moreover, the Office points out that hydrophilic topsheets were known in the art since Duncan uses a hydrophobic topsheet to solve a problem that existed with the use of a hydrophilic topsheet. In response to this rationale, Applicants respectfully offer that the Duncan reference still fails to teach or suggest the disposable article of the present invention that employs a hydrophilic topsheet onto which a lotion is applied in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Therefore, despite the Office's assertion that the present invention would have been obvious at the time of its evolution in view of Duncan, Applicants respectfully assert that this is absolutely not the case. In particular, obviousness of the invention cannot be found since Duncan fails to teach or suggest the desirability of each and every one of the requisite elements of Applicants' invention, namely the hydrophilic topsheet, a lotion applied to the topsheet in a pattern having a plurality of elements, each of the elements having a predetermined size such that the macroscopic regions of the topsheet are untreated, and a percent open area of from about 5 to about 99%. Since §103 requires having to show obviousness of the invention "as a whole," a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. In re Langer and Haynes, 175 USPQ 169, 171 (CCPA 1972). Thus, it is not apparent from the teachings of Duncan in their entirety that Applicants' wholly claimed invention would have been obvious in view of the reference's shortcomings and teachings away. Furthermore, the Board of Patent Appeals and Interferences stated in Ex parte Clapp, 227 USPQ 972 (BPAI 1985):

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references. "

In the present instance, the reference does not expressly or impliedly suggest the claimed combination nor does the Office present the requisite line of reasoning as to why to Applicants' claimed combination would have been obvious in light of the teachings of Duncan.

Based on the aforementioned failed teachings and teachings away from the present invention, Applicants respectfully assert that the present invention would not have been obvious in view of the Duncan disclosure.

Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter (USP 3896807). The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan. Applicants traverse this rejection as well.

Buchalter relates to articles that are placed in contact with the body for use in applying cosmetics or therapeutic substances to the skin, wherein the articles comprise a substrate and a therapeutic or cosmetic composition carried by the substrate and comprising the oil phase of a cream formulation, the oil being a dry emulsifiable solid, which upon addition of moisture thereto forms an oil in water or water in oil emulsion. Given this disclosure, it is clear that Buchalter teaches away from the present invention since it focuses on transferring the lotion or therapeutic substance to the skin via the formation of an emulsion upon mixing with moisture from the skin. In contrast, the lotion of Applicants' claimed method is not dependent upon the presence of moisture for transfer to occur but rather is transferred to the skin or facilitated to transfer via mere normal contact, motion of the wearer, by body heat of the wearer. See, page 13, lines 6-8 of the specification. Applicants therefore respectfully assert that it would not have been obvious to one skilled in the art to modify the subject matter disclosed in either Duncan or Buchalter to arrive at the present invention in view of Buchalter's teaching away.

Assuming arguendo, even if one were to combine the respective disclosures of Duncan and Buchalter to attempt to arrive at the present invention, such an endeavor would fail. This failure would result since both references teach away from certain aspects of the present invention, e.g., the requisite hydrophilic topsheet taught away from by Duncan and the lotion that is transferable to the skin of the wearer without the addition of moisture which is taught away from by Buchalter. These teachings make it clear that one skilled in the art would not have been motivated to arrive at the present invention since the teachings are, in fact, teachings away.

In view of these shortcomings, Applicants respectfully submit that the rejection of claims 33 - 37 under §103(a) over Warner (and Buchalter) is improper. Consequently, Applicants request withdrawal of the rejection and reconsideration.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be

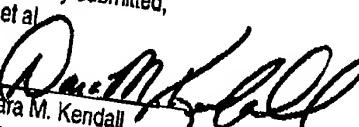
-9-

combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). In the present instance, the "something" is missing. Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983). These cited references, alone and in combination, fail to offer the requisite teaching or suggestion of each of the elements Applicants have claimed as key to the invention. Additionally, it is apparent that Duncan teaches away from a hydrophilic topsheet while the Buchalter reference teaches away from the present invention in its requirement of body fluids to aid in the transfer of the lotion from the article to the skin of the wearer. Thus, Applicants assert that the rejection of obviousness based on both Warner and Buchalter is unfounded.

CONCLUSION

Based on the foregoing statements, Applicants respectfully submit the issue raised by the Office have been addressed in a satisfactory manner. Reconsideration and withdrawal of the rejection is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested as well.

Respectfully submitted,
Roe et al.

By 
Dara M. Kendall
Attorney for Applicants
Registration No. 43,709

April 23, 2003
Customer No. 27752

Received from <513 626 3499> at 4/23/03 4:05:21 PM [Eastern Daylight Time]